

REMARKS/ARGUMENTS

The Office Action mailed May 1, 2006 has been carefully reviewed. Reconsideration of this application, as amended and in view of the following remarks, is respectfully requested. The claims presented for examination are: claims 1-26.

Specification

In numbered paragraphs 1 and 2 of the Office Action mailed May 1, 2006, the Abstract of the Disclosure was objected to because it contains legal phraseology.

The Abstract of the Disclosure has been amended so that it no longer contains legal phraseology.

35 U.S.C. §102 Rejection

In numbered paragraphs 3, 4, and 5 of the Office Action mailed May 1, 2006, claims 1-3, 5-8, and 11-26 were rejected under 35 U.S.C. §102(e) as being anticipated by the Williams reference (US Patent No. 6,338,559).

Applicants have amended the two independent claims, claims 1 and 20, presented for examination; therefore claims 1-3, 5-8, and 11-26 are now presented in amended form. Since claims 1-3, 5-8, and 11-26 now appear in amended form the 35 U.S.C. §102(e) rejection in the Office Action mailed May 1, 2006 no longer applies.

Applicants believe the invention claimed in amended claims 1-3, 5-8, and 11-26 is not anticipated by the Williams reference. The standard for a 35 U.S.C. §102 rejection is stated in RCA Corp. v. Applied Digital Systems, Inc, 221PQ 385, 388 (d. Cir. 1984) "Anticipation is established only when a single prior art reference discloses, either expressly or under principles of inherency, each and every element of a claimed invention."

Applicants point out that the elements of Applicants' amended claims 1-22 identified below are not found in the Williams reference.

"a laser for producing a laser beam of light," or

"producing a laser beam of light utilizing a laser," or

"optic means for directing said laser beam of light to said corrector, to said retina, from said retina to said waveform sensor, and to said testing unit, wherein said optic means includes an adjustable lens," or

"directing said laser beam of light to an adjustable lens."

Since the identified elements are not found in the Williams reference, the Williams reference would not support a 35 U.S.C. §102(e) rejection of amended claims 1-3, 5-8, and 11-26 and the rejection should be withdrawn.

35 U.S.C. §103 Rejection – Williams & Blum

In numbered paragraphs 6, 7, and 8 of the Office Action mailed May 1, 2006, claim 4 was rejected under 35 U.S.C. §103(a) as being unpatentable over the Williams reference in view of the Blum reference (US Patent Application Publication No. 2002/0140899).

Applicants have amended independent claim 1; therefore dependent claim 4 is also now presented in amended form. Since claim 4 now appears in amended form the 35 U.S.C. §103(a) rejection in the Office Action mailed May 1, 2006 no longer applies.

Applicants believe the invention claimed in amended claim 4 is patentable. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966) that are applied for establishing a background for determining obviousness under 35 U.S.C. §103(a) include "Ascertaining the differences between the prior art and the claims at issue." The differences between the Williams reference and Applicants' invention defined by amended

claim 4 includes the fact that the following elements of amended claim 4 are not found in the Williams reference:

“a laser for producing a laser beam of light,” or

“optic means for directing said laser beam of light to said corrector, to said retina, from said retina to said waveform sensor, and to said testing unit, wherein said optic means includes an adjustable lens,” or

“wherein said corrector comprises a liquid crystal spatial light modulator.”

The Blum reference also fails to show the elements of amended claim 4 identified above. Since both references fail to show the elements, there can be no combination of the two references that would show Applicants' invention defined by amended claim 4 and render it unpatentable. There is no combination of the Williams reference and the Blum reference that would produce the combination of elements of Applicants' amended claim 4. Further, there is no teaching of combining the Williams reference and the Blum reference to meet Applicants' amended claim 4. Thus, the combination of references fails to support a rejection of the claims under 35 USC 103(a), and the rejection should be withdrawn.

35 U.S.C. §103 Rejection – Williams & Guirao

In numbered paragraph 9 of the Office Action mailed May 1, 2006, claims 9 and 10 were rejected under 35 U.S.C. §103(a) as being unpatentable over the Williams reference in view of the Guirao reference (US Patent Application Publication No. 2002/0140902).

Applicants have cancelled claim 9. Applicants have amended independent claim 1; therefore dependent claim 10 is also now presented in amended form.

Since claim 10 now appears in amended form the 35 U.S.C. §103(a) rejection in the Office Action mailed May 1, 2006 no longer applies.

Applicants believe the invention claimed in amended claim 10 is patentable. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966) that are applied for establishing a background for determining obviousness under 35 U.S.C. §103(a) include "Ascertaining the differences between the prior art and the claims at issue." The differences between the Williams reference and Applicants' invention defined by amended claim 10 includes the fact that the following elements of amended claim 10 are not found in the Williams reference: Applicants point out that the elements of Applicants' amended claim 10 identified below are not found in the Williams reference.

"a laser for producing a laser beam of light," or

"optic means for directing said laser beam of light to said corrector, to said retina, from said retina to said wavefront sensor, and to said testing unit, wherein said optic means includes an adjustable lens," or

"wherein said adjustable lens is a phoropter."

The Guirao reference also fails to show the elements of amended claim 10 identified above. Since both references fail to show the elements, there can be no combination of the two references that would show Applicants' invention defined by amended claim 10 and render it unpatentable. There is no combination of the Williams reference and the Guirao reference that would produce the combination of elements of Applicants' amended claim 10. Further, there is no teaching of combining the Williams reference and the Guirao reference to meet Applicants' amended claim 10. Thus, the combination of

references fails to support a rejection of the claims under 35 U.S.C. §103(a), and the rejection should be withdrawn.

Under MPEP §2142, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. It should be noted that the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Numbered paragraph 9 of the Office Action mailed May 1, 2006 contains the statement, "it would have been obvious to one of ordinary skill in the art to modify Williams to include an adjustable lens, as taught by Guirao, in order to apply a low-order correction." Applicants point out that the Williams reference and Applicants' claimed invention improve vision by correcting for higher order aberrations. Since the Guirao reference provides a "low-order correction" it would not be obvious to combine the Guirao reference (that provides low-order correction) with the Williams reference (that corrects higher order aberrations).

Since there is no obvious combination of the references to produce Applicants' invention, a 35 U.S.C. §103(a) rejection of Applicants' claim 10 would not be appropriate and should be withdrawn.

SUMMARY

The undersigned respectfully submits that, in view of the foregoing amendments and the foregoing remarks, the rejections of the claims raised in the Office Action dated May 1, 2006 have been fully addressed and overcome, and the present application is believed to be in condition for allowance. It is respectfully requested that this application be reconsidered, that the claims be allowed, and that this case be passed to issue. If it is believed that a telephone conversation would expedite the prosecution of the present application, or clarify matters with regard to its allowance, the Examiner is invited to call the undersigned attorney at (925) 424-6897.

Respectfully submitted,



Eddie E. Scott
Attorney for Applicants
Registration No. 25,220
Tel. No. (925) 424-6897

Livermore, California
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